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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,917	06/29/2001	Hans-Joachim Fuchs	70231	9518
23872	7590	11/01/2006	EXAMINER	
MCGLEW & TUTTLE, PC P.O. BOX 9227 SCARBOROUGH STATION SCARBOROUGH, NY 10510-9227			SHAHER, RICKY D	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/895,917	Applicant(s) FUCHS ET AL.	
	Examiner Ricky D. Shafer	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. In view of applicant's remarks filed on April 14, 2004, the previous restriction requirement mailed on 09/25/2003 is hereby withdrawn. A corrected restriction requirement follows.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 2, drawn to a mirror assembly comprising a mirror foot, a mirror carrier, a first detent element, a first detent contour, a second detent contour and a sliding surface (ABbr), classified in class 248, subclass 478.
 - II. Claims 3, 4 and 8, drawn to a mirror assembly comprising a mirror foot, a mirror carrier, a first detent element, a first detent contour, and a second detent contour with particular details of the first detent element having elastic/spring characteristics (Bsp1), classified in class 248, subclass 477.
 - III. Claims 5-7, drawn to a mirror assembly comprising a mirror foot, a mirror carrier, a first detent element, a first detent contour, and a second detent contour with particular first detent element and first detent contour details of having detent portions (Bsp2), classified in class 248, subclass 478.
 - IV. Claims 9-12 and 16, drawn to a mirror assembly comprising a mirror foot, a mirror carrier, a first detent element, a first detent contour, a second detent contour and a circular retaining element/sleeve (CBbr), classified in class 248, subclass 478.
 - V. Claim 13, drawn to a mirror assembly comprising a mirror foot, a mirror carrier, a first detent element, a first detent contour, a second detent contour and a protruding lug (DBbr), classified in class 248, subclass 478.

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VI. Claim 14 and 15, drawn to a mirror assembly comprising a mirror foot, a mirror carrier, a first detent element, a first detent contour, and a second detent contour with particular mirror carrier or mirror foot details of being of a plastic material (Bsp3), classified in class 248, subclass 478.

2. Claim 1 is link(s) inventions I-VI. The restriction requirement among the linked inventions is **subject to** the nonallowance of the linking claim(s), claim 1. Upon the indication of allowability of the linking claim(s), the restriction requirement as to the linked inventions **shall** be withdrawn and any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104 **Claims that require all the limitations of an allowable linking claim** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

Applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, the allowable linking claim, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions [I, IV, V] and [II, III, VI] are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed

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does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because of the omission of the particular details of the first detent element having elastic/spring characteristic of invention II, the particular details of the first detent element and first detent contour of invention III or the particular details of the mirror carrier or mirror being of a plastic material of invention VI. The subcombination has separate utility such as a mirror assembly without a sliding surface of invention I, a circular retaining element/sleeve of invention IV or the protruding lug of invention V.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Inventions I, IV and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, each of the inventions I, IV and V have separate utility such as a mirror assembly with the separate details of the other invention. For example, the mirror assembly of invention I

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has separate utility as a mirror assembly without a circular retaining element/sleeve of invention IV or the protruding lug of invention V; the mirror assembly of invention IV has separate utility as a mirror assembly without the protruding lug of invention V or the sliding surface of invention I; and the mirror assembly of invention V has separate utility as a mirror assembly without the sliding surface of invention I or the circular retaining element/sleeve of invention IV. See MPEP § 806.05(d).

Inventions II, III and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, each of the inventions II, III and VI have separate utility such as a mirror assembly with the separate details of the other invention. For example, the mirror assembly of invention II has separate utility as a mirror assembly without the first detent element and first detent contour details of invention III or the mirror carrier or mirror foot being of a plastic material of invention VI; the mirror assembly of invention III has separate utility as a mirror assembly without the mirror carrier or mirror foot being of a plastic material of invention VI or the first detent element having elastic/spring characteristics of invention II; and the mirror assembly of invention VI has separate utility as a mirror assembly without the first detent element having elastic/spring characteristics of invention II or the first detent element and first detent contour details of invention III. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable

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subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02) or have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

The search required for invention III would further require a search in class 359, subclass 841 which would not be required for inventions I, IV, V and VI.

The search required for invention IV would further require a search in class 248, subclass 479 which would not be required for inventions I, III, V and VI.

The search required for invention V would further require a search in class 359, subclass 877 which would not be required for inventions I, III, IV and VI.

The search required for invention VI would further require a search in class 359, subclass 872 which would not be required for inventions I, III, VI and V.

5. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricky D. Shafer whose telephone number is (571) 272-2320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the

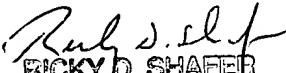
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Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RDS

October 26, 2006


RICKY D. SHAFER
PATENT EXAMINER
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